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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,190	11/17/2000	Xiaoan Hou	196033US28	5420
22850	7590	09/02/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			PARK, CHAN S	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/714,190

Applicant(s)

HOU, XIAOAN

Examiner

CHAN S. PARK

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-11,14-17 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-11,14-17 and 20-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/25/05 has been entered.

### ***Response to Amendment***

2. Applicant's amendment was received on 3/25/05, and has been entered and made of record. Currently, **claims 1, 2, 5-11, 14-17 and 20-24** are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 8 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1, for example, recites that the electronic mail address (fig. 8) includes "an Internet electronic mail address of the fax machine, the input password of the fax machine, and a fax number of a second fax machine ... wherein the fax machine only has wherein the fax machine has only one password and the password of the fax machine is always included in the electronic mail address, even if the image is not to be sent to the second fax machine." Examiner respectfully notes that the Specification fails to disclose/explain a scenario where the image is not sent to the second fax machine even if the fax number of the second fax machine is included in the electronic mail address. Referring to page 9, lines 4-8 of the Specification, it appears that the image is sent to the receiver fax (the second fax) when the fax number of the receiver fax is included in the electronic mail address. Clarification/explanation supporting this limitation is respectfully requested.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5, 6, 8, 9, 11, 14-17, 20, 21, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda et al. U.S. Patent No. 6,330,070 (hereinafter Toyoda) in view of Schlank et al. U.S. Patent No. 5,917,615 (hereinafter Schlank).

4. With respect to claim 1, Toyoda teaches a method of transmitting a facsimile, comprising:

creating an image (data sent by email in col. 2, lines 57-58);

inputting parameters of a fax machine (IFAX 14) from a general purpose computer (PC 12), the parameters including a password of the fax machine (col. 3, lines 59-62; col. 4, lines 54-58; and col. 5, lines 53-57);

forming an electronic mail address that includes an Internet electronic mail address of the fax machine, the input password of the fax machine, and a fax number of a second fax machine (col. 3, lines 59-62; col. 4, lines 54-58; and col. 5, lines 53-57);

generating a fax request as an electronic mail message, the electronic mail message including the electronic mail address and the image (col. 2, lines 57-64); and

transmitting the electronic mail message to the fax machine (col. 2, lines 57-64)

wherein the fax machine has only one password and the password of the fax machine is always included in the electronic mail address (figs 4 & 5b).

Toyoda, however, does not teach expressly that the parameters of the fax machine are inputted to a *graphical user interface* of a general purpose computer.

Schlank teaches a method for transmitting a facsimile, comprising the steps of:

creating an image (fig. 16A);

inputting parameters of a fax machine to a graphical user interface of a general purpose computer (figs. 11-15); and

transmitting the image to the fax machine (fig. 10).

Toyoda and Schlank are analogous art because they are from the same field of endeavor that is the facsimile art.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the graphical user interface of Schlank into the Internet relay facsimile of Toyoda.

The suggestion/motivation for doing so would have been to provide a more user friendly and convenient interface setting as it is widely used in a multifunctional image processing peripheral.

Therefore, it would have been obvious to combine Toyoda with Schlank to obtain the invention as specified in claim 1.

5. With respect to claim 2, Toyoda teaches the method further comprising:  
receiving the electronic mail message by the fax machine (col. 2, lines 59-64);  
analyzing the electronic mail message to determine the fax number of the second fax machine (col. 5, lines 5-26); and

transferring the image form the fax machine to the fax number of the second fax machine (col. 5, lines 21-26).

6. With respect to claim 5, Toyoda teaches the method wherein the transmitting step comprises: transmitting the electronic mail message to the fax machine through the Internet (fig. 1).

7. With respect to claim 6, Schlank teaches a step of selecting the image from a list of images (col. 13, lines 31-59).

8. With respect to claim 8, Toyoda discloses a computer program product including a computer readable medium for transmitting a facsimile, comprising:

an image creating code configured to create an image to be transmitted through the Internet (data sent by email in col. 2, lines 57-58);

a parameter inputting code configured to input parameters of a fax machine to which the image will be transmitted, the parameters including a password of the fax machine (col. 3, lines 59-62; col. 4, lines 54-58; and col. 5, lines 53-57); and

a fax request generating code configured to generate a fax request as an electronic mail message including the image and to send the fax request to the fax machine, the electronic mail message comprising an Internet electronic mail address of the fax machine, the password of the fax machine, a fax number of a second fax machine, and the image to be faxed (col. 2, lines 57-58; col. 3, lines 59-62; col. 4, lines 54-58; and col. 5, lines 53-57),

wherein the fax machine has only one password and the password of the fax machine is always included in the electronic mail address (figs 4 & 5b).

Toyoda does not disclose expressly a graphical user interface configured to allow a user to input parameter of a fax machine to which the image will be transmitted.

Schlank discloses a computer program product including a computer readable medium for transmitting a facsimile including a graphical user interface configured to allow a user to input parameter of a fax machine to which the image will be transmitted (figs. 11-15).

Toyoda and Schlank are analogous art because they are from the same field of endeavor that is the facsimile art.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the graphical user interface of Schlank into the Internet facsimile of Toyoda.

The suggestion/motivation for doing so would have been to provide a more user friendly and convenient interface setting as it is widely used in a multifunctional image processing peripheral.

Therefore, it would have been obvious to combine Toyoda with Schlank to obtain the invention as specified in claim 8.

9. With respect to claim 9, Schlank discloses the computer program product further comprising an image selecting code configured to allow the user to select the image from a list of images (col. 13, lines 31-59).

10. With respect to claim 11, the combination Toyoda and Schlank discloses the graphical user interface comprises:

a control window configured to input parameters of the fax machine (col. 5, lines 53-57 of Toyoda and figs. 11-15 of Schlank);

a setting window configured to input the parameters of the fax machine and mail parameters in order to generate a fax request as an electronic mail message (col. 2, lines 50-64 of Toyoda); and

a print window configured to select a driver to create an image (215 in fig. 19B and col. 21, lines 40-49 of Schlank).



It would have been obvious to combine the method for selecting an appropriate print driver for facsimile of Schlank with the facsimile of Toyoda.

The suggestion/motivation for doing so would have been to correctly convert the image to facsimile document for the facsimile transmission.

Therefore, it would have been obvious to combine Toyoda with Schlank to obtain the invention as specified in claim 11.

11. With respect to claim 14, Toyoda discloses the computer program wherein the image is printed at the fax machine (S705 in fig. 7).

12. With respect to claim 15, Toyoda discloses the computer program wherein the image is printed at the second fax machine (col. 5, lines 25-26). It is assumed that the second fax machine has a printing capability to print the received facsimile data since any conventional fax machine has that capability.

13. With respect to claim 16, arguments analogous to those presented for claims 1 and 8, are applicable.

14. With respect to claim 17, arguments analogous to those presented for claim 2, are applicable.

15. With respect to claim 20, arguments analogous to those presented for claim 5, are applicable.

16. With respect to claim 21, arguments analogous to those presented for claim 6, are applicable.

17. With respect to claim 23, arguments analogous to those presented for claims 1 and 11, are applicable.

18. With respect to claim 24, Schlank discloses the graphical user interface wherein the fax parameters comprise fax document information, receiver information, and sender information (fig. 10).

Claims 7, 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Toyoda and Schlank as applied to claims 1, 8 and 22 above, and further in view of Yashiki U.S. Patent No. 6,512,593.

19. With respect to claim 7, the combination of Toyoda and Schlank teaches the method of claim 1, but it does not teach expressly a method of creating the image in TIFF format.

Yashiki, the same field of endeavor of the Internet facsimile, teaches the method of creating an image in TIFF format for email transmission.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to utilize the TIFF format taught by Yashiki in the Internet facsimile system of Toyoda and Schlank.

The suggestion/motivation for doing so would have been to convert and transmit the facsimile image data in TIFF format in the Internet.

Therefore, it would have been obvious to combine the three references to obtain the invention as specified in claim 7.

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20. With respect to claims 10 and 22, arguments analogous to those presented for claim 7, are applicable.

***Conclusion***


21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
August 23, 2005

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Examiner  
Art Unit 2622

  
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